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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 10/848,931
Filing Date: May 19, 2004
Appellant(s): RASHKOVSKIY ET AL.

_____
Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 13, 2009 appealing from the Office action mailed

February 19, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. The examiner notes that there appears to be a minor mistake in the summary, in that Figures 16 and 20 do not exist in the specification.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,971,119   Arsenault et al.   11-2005

| 6,698,020 | Zigmond et al. | 2-2004 |
| 7,017,173 | Armstrong et al. | 3-2006 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims **1-4, 6-19, 31-47** are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims **20-49** of copending Application No.

09/561,443. Although the conflicting claims are not identical, they are not patentably distinct

from each other, because they are obvious variations of claims **20** and **37** or are variations of

claims that depend therefrom.

Claims **1, 11,** and **31** of the instant application correspond to claims 28 and 43 of the '443

application, where claim 1 recites a method corresponding to the system of claim 28 and claim

11 recites a method performed by instructions executed by a processor-based system

corresponding to claim 28. Claim 31 differs from claim 37 of the '443 application in that it

recites that the content includes "an interruptible content portion." Claim 43, which depends

from claim 37, recites that the receiver parses instructions for determining when said content

may be interrupted. Thus, it is inherent to claim 43 that the content contains an interruptible

content portion, since it determines when the content may be interrupted. Claim 31 also differs

in that it recites outputting "for display, said portion with an inserted advertisement." Claim 46,

which depends from claim 37, recites finding a place to insert the advertisement in the content in

the cache, such that thereafter "the display of content is terminated, followed by display of the

advertisement, followed by resumption of the display of content." Thus, it is inherent to claim

46 that the portion with an inserted advertisement is output for display. As such, the examiner

concludes that claim 31 is an obvious variation of claim 37 of the '443 application, given the

limitations recited in claims dependent on claim 37.

Claim **3** of the instant application corresponds to claim 21 of the '443 application.

Claim **4** of the instant application corresponds to claim 25 of the '443 application.

Claim **6** of the instant application corresponds to claim 26 of the '443 application.

Claim **7** of the instant application corresponds to claim 42 of the '443 application.

Claim **8** of the instant application corresponds to claim 43 of the '443 application.

Claim **9** of the instant application corresponds to claim 22 of the '443 application.

Claim **10** of the instant application corresponds to claim 29 of the '443 application.

Claim **13** of the instant application corresponds to claim 21 of the '443 application.

Claim **14** of the instant application corresponds to claim 25 of the '443 application.

Claim **15** of the instant application corresponds to claim 26 of the '443 application.

Claim **16** of the instant application corresponds to claim 27 of the '443 application.

Claim **17** of the instant application corresponds to claim 28 of the '443 application.

Claim **18** of the instant application corresponds to claim 22 of the '443 application.

Claim **19** of the instant application corresponds to claim 29 of the '443 application.

Claim **32** of the instant application corresponds to claim 21 of the '443 application.

Claim **33** of the instant application corresponds to claim 38 of the '443 application.

Claim **34** of the instant application corresponds to claim 39 of the '443 application.

Claim **35** of the instant application corresponds to claim 40 of the '443 application.

Claim **36** of the instant application corresponds to claim 41 of the '443 application (where it is well-known within the prior art that a shell provides an interface for performing the desired function).

Claim **37** of the instant application corresponds to claim 26 of the '443 application.

Claim **38** of the instant application corresponds to claim 42 of the '443 application.

Claim **39** of the instant application corresponds to claim 43 of the '443 application.

Claim **40** of the instant application corresponds to claim 29 of the '443 application (where it is well-known within the prior art that a shell provides an interface for performing the desired function).

Claim **41** of the instant application corresponds to claim 44 of the '443 application.

Claim **42** of the instant application corresponds to claim 45 of the '443 application (where it is well-known within the prior art that a shell provides an interface for performing the desired function).

Claim **43** of the instant application corresponds to claim 32 of the '443 application.

Clam **46** of the instant application corresponds to claim 46 of the '443 application.

Claims 2 and **12** are obvious variations of the '443 application, because receiving content over a broadband distribution system is well known within the prior art, as disclosed by U.S. Patent No. 6,971,119 to Arsenault et al. Such a modification is desirable in order to increase the information-carrying capacity of an information channel.

Claims **44**, **45**, and **47** are obvious variations of the '443 application, because detecting a pause in the display of content and inserting an advertisement in response to the pause is well known within the prior art, as disclosed by U.S. Patent No. 7,017,173 to Armstrong et al. Such a

modification is desirable in order to put "freeze frame" or other similar display imagery to greater uses (Armstrong et al. col. 1, l. 63-67).

NOTE: This is a <u>provisional</u> obviousness-type double patenting rejection.

2.   Claims **1-3, 6, 7, 10-13, 15, 16, 19, 31, 32, 37, 38, 40, 42, 43, 46** are rejected under 35 U.S.C. 102(e) as being anticipated by Arsenault et al.

         Referring to claims **1, 11,** and **31**, Arsenault et al. discloses a method/medium/system comprising:

-   receiving content and an advertisement (col. 17, l. 53-67; col. 18, l. 1-19; & Fig. 8);

-   storing said content, including an interruptible content portion, and advertisement in a cache coupled to said receiver (col. 17, l. 53-67; col. 18, l. 1-19; & Fig. 8);

-   analyzing the content to identify a location to insert the advertisement within the content and, based on said analysis (col. 18, l. 1-5), finding a place to insert said advertisement (164, 168) in said portion while said portion is still stored in said cache (col. 18, l. 1-19 & Fig. 8);

-   inserting said advertisement in said portion (Fig. 8); and

-   outputting for display (164, 168) said portion with said inserted advertisement (Fig. 8).

         Referring to claims **2** and **12**, Arsenault et al. discloses the method/medium of claims 1 and 11, respectively, including receiving said content over a broadband distribution system (col. 3, l. 36-43 & col. 4, l. 3-6).

Referring to claims **3** and **13**, Arsenault et al. discloses the method/medium of claims 2 and 12, respectively, including receiving television programming (col. 3, l. 36-38 & col. 4, l. 65-67).

Referring to claims **6, 15,** and **37**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, including a tuner that tunes to a digital channel and demodulates said content and advertisement (col. 9, l. 34-40, 63-64 & Fig. 3).

Referring to claims **7, 16,** and **38**, Arsenault et al. discloses the method/medium/system of claims 6, 15, and 31, respectively, including parsing said content and said advertisement from control information (col. 5, l. 20-29; col. 9, l. 63-67; & col. 10, l. 1-10).

Referring to claims **10, 19,** and **40**, Arsenault et al. discloses the method/medium/system of claims 1, 11, and 31, respectively, including receiving encrypted content and a shell controlling the decryption of said content to prevent theft of said content (col. 15, l. 1-11).

Referring to claim **32**, Arsenault et al. discloses the system of claim 31, wherein said system is a television receiver (Fig. 3).

Referring to claim **42**, Arsenault et al. discloses the system of claim 31, wherein said shell is coupled to said cache to allow the use of the content received by said receiver, automatically interrupt the use of the content, and temporarily replace the content with the advertisement (col. 18, l. 1-19 & Figs. 3, 8).

Referring to claim **43**, Arsenault et al. discloses the system of claim 31, wherein said cache is an encrypted cache (the data is stored in an encrypted MPEG format)(col. 10, l. 11-24).

Referring to claim **46**, Arsenault et al. discloses the method of claim 1, including displaying content information with said advertisement (Fig. 8).

3.   Claims **4**, **8**, **9**, **14**, **17**, **18**, **33-36**, **39**, **41** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Arsenault et al. in view of Zigmond et al.

        Referring to claims **4**, **14**, and **36**, Arsenault et al. discloses the method/medium/system

of claims 1, 11, and 31, respectively, wherein inserting the advertisement in said portion includes

a shell that replaces at least part of said content with the advertisement (col. 18, l. 1-19 & Fig. 8).

Arsenault et al. does not specifically disclose periodically replacing content with a single ad.

Zigmond et al. discloses a system and method for selecting and inserting advertisements into a

video programming feed at the household level (see Abstract). Zigmond et al. further discloses

inserting the same ad into content multiple times (col. 13, l. 40-45). It would have been obvious

to one of ordinary skill in the art at the time that the invention was made to modify Arsenault et

al. to insert the same advertisement multiple times, such as that taught by Zigmond et al. in order

to provide an improved system for directing television advertisements to interested viewers

(Zigmond et al. col. 3, l. 62-64).

        Referring to claims **8**, **17**, **34**, and **39**, Arsenault et al. discloses the

method/medium/system of claims 7, 16, and 31. Arsenault et al. does not disclose that parsing

content from control information includes parsing from said content, instructions for determining

when said content may be interrupted. Zigmond et al. discloses a system and method for

selecting and inserting advertisements into a video programming feed at the household level (see

Abstract). Zigmond et al. further discloses inserting the advertisements at an appropriate time

based on a triggering event, which may be a time specified by encoded data in the video

programming feed (col. 4, l. 40-43; col. 7, l. 26-29; & col. 17, l. 21-31). It would have been

obvious to one of ordinary skill in the art at the time that the invention was made to modify

Arsenault et al. to encode a time for inserting advertisements into the video programming, such

as that taught by Zigmond et al. in order to provide an improved system for directing television

advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claims **9**, **18**, and **33**, Arsenault et al. discloses the method/medium/system

of claims 7, 16, and 31, respectively. Arsenault et al. does not disclose receiving instructions

from a back channel for controlling the interruption of said content. Zigmond et al. discloses a

system and method for selecting and inserting advertisements into a video programming feed at

the household level (see Abstract). Zigmond et al. further discloses delivering ad selection rules

over telephone or downloading them from the World Wide Web (col. 11, l. 66-67 & col. 12, l. 1-

9). The ad selection rules match the viewer with the advertisements to efficiently target desired

viewers of particular advertisements (col. 11, l. 43-49). It would have been obvious to one of

ordinary skill in the art at the time that the invention was made to modify Arsenault et al. to

include receiving ad selection rules over telephone or from the World Wide Web, such as that

taught by Zigmond et al. in order to provide an improved system for directing television

advertisements to interested viewers (Zigmond et al. col. 3, l. 62-64).

Referring to claim **35**, the combination of Arsenault et al. and Zigmond et al. teaches the

system of claim 34, wherein said device also parses instructions for how to store said content and

said advertisement (Arsenault et al. col. 15, l. 1-11 & col. 18, l. 1-19).

Referring to claim **41**, the combination of Arsenault et al. and Zigmond et al. teaches the

system of claim 35, including content guide software to receive interruption instructions for

interrupting said content and replacing it with said advertisement (see claim 8 above)(Zigmond

et al. col. 17, l. 21-31).

4.   Claims **44, 45, 47** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Arsenault et al. in view of Armstrong et al.

Referring to claims **44, 45**, and **47**, Arsenault et al. discloses the method of claim 1.

Arsenault et al. does not disclose that the finding includes detecting that a user paused using said

content, and retrieving said advertisement from said cache when it is detected that said user

paused using said content. Arsenault et al. further does not disclose that the detecting includes

detecting that the user temporarily stopped using the content. Arsenault et al. still further does

not disclose inserting said advertisement in response to a pause in the display of said content.

Armstrong et al. discloses presenting advertisements to a user in response to the user pausing

video-on-demand content (col. 2, l. 14-22, 63-67; col. 3, l. 1-3; & Fig. 4). It would have been

obvious to one of ordinary skill in the art at the time that the invention was made to modify the

ad insertion of Arsenault et al. to include inserting advertisements in response to a user pausing

content, such as that taught by Armstrong et al. in order to put "freeze frame" or other similar

display imagery to greater uses (Armstrong et al. col. 1, l. 63-67).

(10) Response to Argument

**Argument A: Are claims 1-3, 6, 7, 10-13, 15, 16, 19, 31, 32, 37, 38, 40, 42, 43, and 46
anticipated under 35 U.S.C. § 102(e) by Arsenault?**

Regarding claims **1-3, 6, 7, 10-13, 15, 16, 19, 31, 32, 37, 38, 40, 42, 43**, and **46**, the
appellant argues that there is no inserting of advertisements within the content in Arsenault, but,
instead, the advertisements are inserted between discrete content. The appellant specifically
argues that there is no interruption at all in Arsenault, but, instead, data packets, like packets
170a and 170b, are integral units between which is placed an ad 174a, as shown in Figure 8. The
examiner respectfully disagrees.

Arsenault et al. discloses receiving a transmission stream 160 that includes movie or
program data 170, additional material data 172, and advertising material data 174. For example,
the broadcaster can send a collection of edited versions of a program, "director's cuts,"
corresponding program guide data, associated applications, or other auxiliary material
corresponding to the selected program (col. 17, l. 53-67). The data of the transmission stream is
cached locally at the receiver at the request of the viewer or upon the decision of the broadcaster
(col. 14, l. 51-55). Based on the intended use of additional material 172 and advertising 174 for
playback of cached program 170, CPU 74 of the receiver organizes and retrieves data packets
from additional cache memory 92 in appropriate order (col. 18, l. 1-5). This is illustrated in
Figure 8, where the transmission stream is received as illustrated at 160, but played back in
accordance with playback options 162, 164, 166, or 168 based on the intended use of the
additional material and advertising (Fig. 8). In the example of Figure 8, a transmission stream
160 includes movie or program data 170, additional material 172, and advertising material 174.
Playback option 162 shows cached program 170 displayed in an uninterrupted format. Playback
option 164 shows cached program 170 broken up into multiple segments 170A-170D and
advertising segments 174A-174C interspersed between them. Playback option 166 shows

cached program 170 divided into multiple segments 170A-170C and additional material

segments 172A and 172B interspersed between them. Playback option 168 shows cached

program 170 divided into segments 170A-170D and advertising segments 174A and 174B and

additional material segments 172A and 172B interspersed between segments 170A-170. Thus,

Arsenault et al. allows a movie to be played from the additional cache memory 92 with

additional material 172 or advertising 174 appearing throughout the movie (col. 18, l. 1-19).

        The examiner interprets the movie or program data to be "content," as currently claimed.

The packetized nature of this content is not indicative of multiple packets of unrelated content,

but is a consequence of the transmission and storage of the content. Arsenault et al. notes that a

combiner 42 of the transmission station 26 groups encoded digital data (movies, television

programs, etc.) into a plurality of packets and marks them with SCIDs (col. 14, l. 50-67). If a

packet is identified as caching data, the packet is output to additional cache memory 92, where it

is stored in a data file. Additional cache memory can be a hard disc drive or other suitable

memory device with a large storage capacity (col. 10, l. 11-24). Appellant's invention operates

in similar fashion, as noted on pages 5 and 6 of Appellant's specification. Appellant's

specification states that content is acquired from a source and stored through the shell into the

hard disk drive, where it is stored in a form which can be accessed by the shell thereafter. To

access the content, one must access the content through the shell, because only the shell knows

where all the portions of the content are stored and how to reconstruct it in a meaningful fashion

(p. 6, lines 23-26 & p. 7, lines 1-3 of Appellant's specification). Thus, it appears the content of

Appellant's invention is also broken into portions in the cache.

Appellant suggests that 170a and 170b of Figure 8 of Arsenault et al. are examples of

packets; however, this is not disclosed or suggested by Arsenault et al. Arsenault et al. describes

the packets as being a result of the encoding and storage functions (col. 14, l. 50-67 & col. 15, l.

19). When a user selects a cached program for viewing, CPU 74 locates the MPEG data file in

additional cache memory 92 containing the selected program and retrieves data from the

appropriate MPEG data file and loads portions of the MPEG data file into memory 78 (col. 17, l.

8-14). Arsenault et al. states that playback option 164 shows cached program 170 broken up into

multiple segments 170A-170D and advertising segments 174A-174C interspersed between them

(col. 18, l. 1-9). That is, Arsenault et al. does not disclose or suggest that the packets and

segments are the same. This point is irrelevant; however, because the examiner interprets the

movie or content, as a whole, to be the "content," as currently claimed. The examiner believes

this to be a reasonable interpretation of the content, especially given page 6, lines 23-26 and page

7, lines 1-3 of Appellant's specification and the fact that Arsenault et al. describes the sum of the

packets as an MPEG file containing the program (col. 17, l. 8-14). A comparison of 160 and 162

to 164, 166, or 168 in Figure 8 illustrates that Arsenault et al. intends the program to be one

continuous, single program (Star Wars, for example), with or without ads inserted on playback

(Fig. 8). As such, the examiner maintains that Arsenault et al. discloses inserting an

advertisement into content, as currently claimed.

Further regarding claims **1-3**, **6**, **7**, **10-13**, **15**, **16**, **19**, **31**, **32**, **37**, **38**, **40**, **42**, **43**, and **46**,

the appellant argues that there is no analysis of each of the discrete content segments, such as the

segment 170a or 170b to determine a location to insert the advertisement. The appellant

specifically argues that the advertisement is simply played or not played at the end of a discrete

segment. The appellant further specifically argues that all that is done is that the CPU organizes

and retrieves the data packets from memory 92 in appropriate order and that the discrete packets

are simply ordered and a decision is not made to analyze the content to identify a location to

insert an advertisement. The examiner respectfully disagrees. As noted by Arsenault et al. in

Figure 8, the content is received with the movie transmitted in sequential order and having

additional material and ads appended to the end of the stream. Playback options 162, 164, 166,

and 168 intersperse the ads, additional material, or both within the content for playback (Fig. 8).

Arsenault et al. further discloses that, based on the intended use of additional material 172 and

advertising 174 for playback of cached program 170, CPU 74 organizes and retrieves respective

data packets from additional cache memory 92 in appropriate order (col. 18, l. 1-5). The

examiner notes that this organizing of data packets in *appropriate* order requires an analysis of

the content (italicized for emphasis). Appellant argues that, instead, there is simply some listing

that is done of individual packets that are put in a particular order where the packets include both

content and advertising and does not mean that there was any analysis of the content to identify a

location to insert the advertisement. Appellant further argues that it is equally plausible, if not

more so, that all that was done is that a set member of content packets are provided so that ads

174a are provided at appropriate times or appropriate intervals, as shown in 164 or 168 in Figure

8. The examiner notes that this is not stated by Arsenault et al., but even if this were true,

analysis of the content would still be required. That is, playback of the first packet of advertising

would require that playback of the previous packet of the program were finished playing. Thus,

it still requires some analysis of the content. Arsenault et al. also discloses that the viewer can

choose to watch the "director's cut" of the movie, where portions of the movie that were

removed in the commercial version can be placed back in as the director initially intended (col. 18, l. 25-29). Arsenault et al. still further discloses that a user can play an application along with playback of a "Jeopardy" program that allows the user to play along with the program (col. 18, l. 50-54).

Appellant further states that, as an example, one could analyze the content to determine the best time to break the content with an advertisement and that the reference does not do that. The examiner acknowledges this; however, Appellant's claim does not require this type of analysis, nor is this type of analysis supported by Appellant's specification. Appellant's specification states that a shell 22 monitors a criteria which determines when the content's use is to be interrupted with interrupting content. The shell 22 may force a mechanism wherein interrupting content may be temporarily played in place of interruptible content (p. 7, lines 11-15 of Appellant's specification). Both Appellant's specification and dependent claim 4, further indicate that the interrupting content may be inserted at regular or periodic intervals, for example, or inserted when advantageous conditions arise (p. 7, lines 20-22 of Appellant's specification). Appellant's specification states that, in connection with gaming software, when the user reaches a stopping point, the system may determine that the action has paused sufficiently that the interrupting content may be inserted (p. 7, lines 23-26 of Appellant's specification). This also does not suggest the type of analysis suggested by Appellant's arguments. Inserting ads based on determining that the user reaches a stopping point may depend on whether the user stops using game controls, for example, and not depend on the content itself.

The appellant further argues that the order of playback may be predetermined by another entity, and that then all the CPU does is provide the segments in the predetermined order. The appellant still further argues that there is no reason to believe that anyone analyzes the content to decide where the advertisement should go within the content, and that instead, someone could simply provide a sequence and that sequence is followed at the CPU. The examiner notes that this is not stated by Arsenault et al., but even if this were true, analysis of the content would still be required. That is, the CPU would have to analyze the content to know that the previous content packet of the sequence has been played before outputting the next packet, the first packet of the advertising sequence. The examiner further notes that Appellant's specification, and dependent claim 9, describe receiving instructions from a back channel for controlling the interruption of the content (p. 4, lines 25-26 & p. 5, lines 1-2 of Appellant's specification). As such, the examiner maintains that Arsenault et al. teaches the limitations of claim 1, as currently claimed.

Argument B: Are claims 4, 8, 9, 14, 17, 18, 33-36, 39, and 41 unpatentable under 35 U.S.C. § 103(a) over Arsenault in view of Zigmond?

Regarding claims **4, 8, 9, 14, 17, 18, 33-36, 39, and 41**, the appellant argues that the rejection should be reversed for the reasons set forth in Section A. The examiner respectfully disagrees for the reasons stated above.

Argument C: Are claims 44, 45, and 47 unpatentable under 35 U.S.C. § 103(a) over Arsenault in view of Armstrong?

Regarding claims **44**, **45**, and **47**, the appellant argues that the rejection should be reversed for the reasons set forth above in Section A. The examiner respectfully disagrees for the reasons stated above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Michael Van Handel

/Michael Van Handel/

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